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Our Case No. 8285-633

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)		
Pickard et al.)		
)	Examiner:	Deane
Serial No.: 10/664,049)		
)	Group Art Unit:	2642
Filed: September 15, 2003)		
)		
For: Method, System and Medium for)		
Plug-and-Play Downloading of)		
Speed Dial Lists)		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the attached sheets. No more than five (5) pages are provided.

I. The Wrong Test for 35 U.S.C. § 112, Second Paragraph, Was Applied

In the Final Office Action mailed July 28, 2005, Claims 1-18 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention. The Examiner asserted that the claims are ambiguous because they do not provide a detailed explanation of “how the system works.” Applicants respectfully traverse this rejection, as it appears the Examiner may be confusing the 35 U.S.C. § 112, second paragraph, requirement with the enablement requirement in 35 U.S.C. § 112, first paragraph.

35 U.S.C. § 112, second paragraph, states: “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” As explained in MPEP 2173, “[t]he primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.” In this way, 35 U.S.C. § 112, second paragraph, requires claims to serve a notice function by providing clear warning to others as to what constitutes infringement of the patent. MPEP 2173.02.

The claims meet this requirement. For example, independent Claim 1 clearly defines the scope of the invention by reciting a method that comprises detecting that a telephone set has been connected to a telephone line; and in response to the detection: identifying the telephone line to which the telephone set has been connected; retrieving a speed dial list from a database based on the identifying, wherein the speed dial list is associated in the database with the telephone line; and communicating the speed dial list associated with the telephone line to the telephone set.

The Office Action is asserting that the claims do not meet the 35 U.S.C. § 112, second paragraph, requirement because they do not place a limit on how many times a speed dial list is

sent. However, such a limitation is not needed to inform the public of what constitutes infringement. Further, it appears that the rejection is due to the claims' breadth and not because the claims do not inform the public of the boundaries of what constitutes literal infringement. However, MPEP 2173.04 makes clear that this is not a proper ground for rejection: "Breadth of a claim is not to be equated with indefiniteness."

The Office Action is also asserting that the claims do not meet the 35 U.S.C. § 112, second paragraph, requirement because the claims do not describe "how the system works." Applicants note that providing a detailed description to enable one skilled in the art to make and use the invention is a requirement of 35 U.S.C. § 112, *first* paragraph (not 35 U.S.C. § 112, *second* paragraph), and the *specification* (not the claims) needs to satisfy that requirement. Here, the specification clearly provides an enabling description (see page 7, line 1 to page 8, line 26 for a description of the various implementation details questioned by the Examiner). That the claims do not recite all of these implementation details is not a proper ground of rejection under 35 U.S.C. § 112, first paragraph.

In summary, because the claims fully meet the requirements of 35 U.S.C. § 112, second paragraph, Applicants respectfully request that the 35 U.S.C. § 112, second paragraph, rejections be removed.

II. The 35 U.S.C. § 102(b) Rejections Are Not Directed to the Pending Claims

Claims 1-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,930,350 to Johnson. However, the Office Action cited claim elements that are not recited in any of the pending claims (e.g., storing the speed dial list in a database and associating, in the database, the speed dial list with an identifier of the telephone line). Instead, those claim elements were recited in the original version of Claim 1 of the *parent* application. For this reason alone, the rejections should be withdrawn.

With respect to independent Claims 1, 8, and 13 in the pending application, it appears that the Examiner's concern is that the phrase "in response to" can read on any system that sends a speed dial list to a remote phone, since a connection would have to be sensed by the system before the speed dial list is sent. However, Claim 1 recites two acts that take place in response to detecting that a telephone set has been connected to a telephone line: identifying the telephone line to which the telephone set has been connected and retrieving a speed dial list from a database based on the identifying, wherein the speed dial list is associated in the database with the telephone line. Similar elements are recited in independent Claims 8 and 13. These elements are not shown in Johnson. Johnson discloses a system where phone numbers in a pre-programmed database are assigned to a speed dial list in response to a user receiving an *email, fax, or printout* – ***not in response to detecting a telephone set has been connected to a telephone line as recited in the claims***. Johnson does not perform any function whatsoever in relation to a speed dial list when a telephone set is connected to a telephone line.

Further, these added elements are similar to those added to original Claim 1 in the parent application, which caused the Examiner to allow that claim. Original Claim 1 in the parent application was also rejected as being anticipated by Johnson. In response to that rejection, Applicants amended original Claim 1 in the parent application to state that the acts of identifying the telephone line to which the telephone set has been connected, retrieving the speed dial list from the database based on said identifying, and communicating a machine-readable form of the speed dial list to the telephone set via the telephone network were performed in response to detecting that a telephone set has been connected to the telephone line. The Examiner agreed that Johnson did not teach performing these acts in response to detecting that a telephone set has been connected to the telephone line and withdrew the rejections and allowed the application.

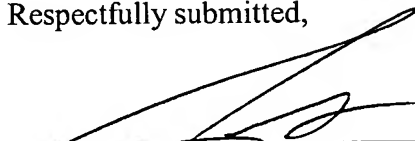
Accordingly, because the Examiner allowed the claim with these elements before, he should allow claims with those elements now.

With respect to independent Claim 7, that claim recites receiving a telephone call automatically placed by a telephone set in response to the telephone set being connected to a telephone line. Claim 7 also recites receiving, within that automatically-placed telephone call, a selection of an option to download a speed dial list. These elements are not shown in Johnson. In Johnson, phone numbers in a pre-programmed database are assigned to a speed dial list in response to a user receiving an email, fax, or printout. There is no teaching in Johnson of receiving a telephone call automatically placed by a telephone set in response to the telephone set being connected to a telephone line and receiving, within that automatically-placed telephone call, a selection of an option to download a speed dial list.

Dated:

1-26-06

Respectfully submitted,



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